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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,051

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Yukio Nakagawa

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11/22/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,051

Applicant(s)

NAKAGAWA ET AL.

Examiner

David J. Joy

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6, 8-11, and 24 are pending, with Claims 1 and 8 being considered as amended on September 7, 2006, and Claim 24 being added as of that date. Claim 7 has been cancelled, and Claims 12-23 are withdrawn from consideration.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claim 24 is objected to because of the following informalities: the phrase "a stripe of packaging material" appears in the fourth line of the claim, whereas the phrase "a strip of packaging material" had been used throughout the claims. Appropriate correction is required.

Information Disclosure Statement

4. Applicant has supplied a copy of a certified English translation of Japanese Patent Application No. 2002-230280 (hereinafter "Nakagawa"). Accordingly, the examiner has considered the reference as submitted.

Response to Amendments

5. Applicant's amendments to Claims 1 and 8 and the cancellation of Claim 7, filed September 7, 2006, renders the previously cited rejections under 35 U.S.C. §102 moot.

6. The rejection of Claims 1-6 and 9-11 under 35 U.S.C. §102(b) as being anticipated by the Japanese Patent Application of Takazono et al. (JP 2001-055202; hereinafter "Takazono") has been withdrawn.

7. The rejection of Claims 1-6, and 10 under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent of Sacchetti et al. (6,588,666; hereinafter "Sacchetti") has been withdrawn.

8. The rejection of Claims 1-11 under 3.5. U.S.C. §102(e) as being anticipated by the U.S. Patent of Maruhashi et al. (6,817,789; hereinafter "Maruhashi") has been withdrawn.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 8 and 24 are rejected under 35 U.S.C. §102(b) as being anticipated by Takazono.

11. In terms of Claim 8, Takazono teaches a roll of packaging material that includes a wound strip of packaging material and a recording medium provided on the wound strip of packaging material and readably recording packaging related information where the recording medium includes a contact recording medium readable in a contact fashion (see Figures 4, 5, and 6; see also ¶¶ [0039] – [0043]). The packaging material is wound and there is a recording medium (e.g., barcodes, symbols, etc.) that can indicate packaging related information. Further, this information can be read by a reading

means that will interpret the readably recorded information and respond to that information.

12. As for Claim 24, Takazono teaches a roll of packaging material that is attachable to a support shaft provided with a reading device. Takazono further teaches a hollow core having in inner surface, a strip of packaging material wound around the hollow core, and a recording medium provided on the inner surface of the hollow core and recording packaging related information readably by the reading device (see Figures 7(a) and 7(b); see also ¶ [0045]). The packing paper is provided on a paper tube, with the detection means that faces the paper tube so as to be able to detect the recorded packaging-related information. Further, the recording medium is provided along the curved surface of the tube (or, it may also be embedded within the tube), and the reading device detects the recorded information.

13. Additionally, in terms of both Claims 8 and 24, the phrase “for use in packaging a product” that appears in Line 3 and in Lines 4 and 5 of the claims, respectively, merely recite the intended use of the packaging material. The addition of that limitation does not structurally or materially define anything over that which is taught by the reference.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takazono in view of the U.S. Patent Application Publication of Zimmerman et al. (2003/0229543; hereinafter "Zimmerman").

17. With regard to Claim 1, Takazono teaches (see Figures 1 and 2) a wound strip of packaging material (10) and a recording medium provided on the wound strip with readably recorded packaging related information thereon (11). However, Takazono is silent as to the inclusion of an identifier tag capable of electromagnetically storing the information and readable in a non-contact fashion through a resonance phenomenon of radio waves. Zimmerman, drawn to a system for centralized management of packaging data, teaches the inclusion of a radio frequency identification (“RFID”) tag that can be programmed with packaging data (see ¶ [0038]). Given that both of the references apply to the same or analogous fields of invention, it would have been obvious to a person having ordinary skill in the art to include such an identifier tag that is capable of electromagnetically storing the packaging information and reading it in a non-contact fashion through the resonance phenomenon of radio waves.

1. As for Claim 2, Takazono discloses including a packaging condition on the material (see ¶¶ [0009] – [0011]). The Takazono material is such that the identifier possesses rate detection means to detect the reading rate and control the discharge of wrapping paper.

2. In terms of Claim 3, Takazono provides information related to a material of the strip (see ¶ [0009]). The pieces of identification include the type of a wrapping paper that can be used.

3. Regarding Claim 4, the material in Takazono includes information related to the fabrication of the strip (see ¶ [0009]). The pieces of identification show the material of which the strip may be fabricated.

4. As for Claim 5, Takazono teaches the inclusion of a packaging material identifier (see ¶ [0009]). The identity of the packaging material is incorporated into the pieces of information located on the wound strip.

5. In terms of Claim 6, Takazono addresses the inclusion of a product identifier (see ¶¶ [0009] – [0011]). The correlation between the packaging material and the contents is placed on the identifier, and the presence of a different identifier is capable of being detected as such.

6. As far as Claims 5 and 6 are concerned, the phrases “for identifying said strip of packaging material” and “for identifying said product to be packaged” merely recite

the intended use of the identifier. Applicant's present claims do not structurally or materially define anything over that which is taught by Takazono.

7. With regard to Claim 9, Takazono shows in Figure 7, the wound strip of material having a hollow core (9) and the recording medium (21) being provided near the hollow core.

8. In terms of Claim 10, Takazono teaches (see Figures 2, 4 and 5) a recording medium (11, 11a, 11b and 11c) at an end of or near an end of the outermost periphery of the wound strip of material.

9. As for Claim 11, in Figure 6, Takazono teaches a recording medium provided on a sheet-like member affixed to an end (10a and 10b) of the outermost periphery of the wound strip of material.

10. In Claims 1-6, the inclusion of such phrases as "for use in packaging a product" (see Claim 1) and "for packaging the product using said strip of packaging material" (see Claim 2) does not positively recite any definite structure over that which is taught by the Takazono patent. Applicant has simply recited a condition for packing the

product, which merely refers to the intended use of the recording medium.

Furthermore, applicant has not positively recited a product but only a “material” that could potentially be used “in packaging a product” which defines nothing structurally distinct over that of the “paper” as taught by Takazono.

Response to Arguments

18. Applicant's arguments filed September 7, 2006 have been fully considered but they are not persuasive.

19. Given the new grounds of rejection (hereinabove), Applicant's arguments are deemed moot.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

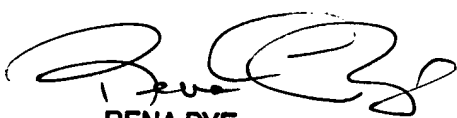
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJJ
11/16/2006


RENA DYE
SUPERVISORY PATENT EXAMINER
Art Unit 1774
11/17/06